

### **DETAILED ACTION**

***The following is in response to the RCE and amendments/remarks filed 11/25/2009. Claims 1-59 are pending.***

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11/25/2009 has been entered.

#### ***Drawings***

The drawings are objected to because figures 10-16, 18-38 and 41-43 include handwritten reference numerals difficult to read and shading in the figures obscures the figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and

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appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The rejections under 35 USC 112 second paragraph have been withdrawn in view of the BPAI decision dated 9/25/2009.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 09/732008. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

A "forum" encompasses a "collaboration tool" and a "library of resources" encompasses a "database".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7-19, 22-32, 34-46, 49-54, 57-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. (US 5940843).

Zucknovich et al discloses a method for providing a tool with which a client and one or more participants may interact. A client defines a collaboration team comprising one or more participants (col 1, Lines 50-56). The client submits client data to the tool in a common format (col 5, lines 60-67). The participants comprise one or more entities authorized by the client to participate in the tool, wherein the client also defines the scope of authorization for each participant (col 6, lines 25-30). The client interacts with one or more participants through the tool, wherein interaction among participants comprises exchange of client data (col 87, Lines 14-50). The participants may be financial advisors (col 5, lines 55-56).

The client data comprises financial documents as a work product (col 2, Lines 41-50). There is enabled the client to access a client history database wherein the client history database maintains information related to previous actions (col 83, Lines 26-45). A library of resources is disclosed since there is taught access to the Internet. Zucknovich et al does not use the word "forum" to describe what their tool provides.

It would have been obvious to one with ordinary skill in the art to include a common "forum" as describing the tool to Zucknovich et al because Zucknovich et al teach that research providers require interaction with those who desire their work product (col 1, Lines 39-44).

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Claims 6, 20-21, 33, 47-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich as applied to claims above, and further in view of Moran (US-6,430,542 B1).

Zucknovich et al does not disclose a calendar function or planning means for enabling participant to formulate a financial plan. Moran discloses a calendar function (fig 37) and a planning means for enabling participant to formulate a financial plan (col 1 , lines 21-30).

It would have been obvious to one with ordinary skill in the art to include a calendar function to Zucknovich et al because Moran teaches that planning requires knowing timelines for answering planning questions (col 32, Lines 1 1-30).

It would have been obvious to one with ordinary skill in the art to include planning means for enabling participant to formulate a financial plan to Zucknovich et al because Moran teaches that financial advisors provide financial planning (col 1, Lines 25-26) and Zucknovich et al teaches advisors.

Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. as applied to claims above, and further in view of Carter (US 5787175).

Zucknovich et al does not disclose use of "encryption".

Carter discloses encryption of documents (fig 11).

It would have been obvious to one with ordinary skill in the art to include encryption to Zucknovich et al because Carter teaches encryption advantages to control access of documents (col 4, lines 1-18).

Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. as applied to claims above, and further in view of Day et al. (US6243722).

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Zucknovich et al does not disclose enabling the financial services client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data.

Day et al discloses disclose enabling the client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data (col 3, Lines 45-67., col 4, Lines 1-25).

It would have been obvious to one with ordinary skill in the art to include participant input wherein participant input comprises one or more or edits, analysis and comments related to client data because Day et al teaches collaborative efforts require edits, analysis and comments (col 3, lines 45-64, col 4, lines 6-25), and Zucknovich et al teaches correction for inaccuracies of client data (col 1, lines 62-67, col 2, lines 1-25).

### ***Response to Arguments***

Applicant's arguments filed 11/25/2009 have been fully considered but they are not persuasive.

With regards to applicant's arguments that Zucknovich makes no mention that the investors (or users) define a collaboration team having multiple financial advisors, and provide a scope of authorization for respective financial service provider participants to access data of the investor or user, Examiner disagrees. Applicant's Specification does not specifically define the term "forum", nor does it utilize the term contrary to its customary meaning (FF 1, 2). The ordinary and customary definition of the term "forum" is a medium (as a newspaper) of open

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discussion or expression of ideas. (FF 3). In Zucknovich contributors via contributor workstations are used by brokerage and investment banking firms to submit or post reports to the repository server 2. (FF 4). The reports are investment research reports. (FF 5). In turn, [t]he repository server 2 provides investors with lists of reports received from the contributor workstations and the investor can select reports from these lists to down-load, view and/or print (FF 6). The ordinary and customary definition of the term "interaction" is defined inter alia as mutual action or influence (FF 10). The repository server 2 thus serves as a common or mutual resource medium for investors, influencing them by the analysis of the reports which are downloaded and read. Therefore, the process of a contributor posting a report on the repository server and an investor subsequently downloading same from the repository server constitutes interaction through a common forum thereby meeting the claim language.

With regards to applicant's arguments that Zuchnovich doesn't teach or suggest making the financial services client data selectively accessible to authorized ones of the financial service provider participants via a common electronic forum that enables the financial service participants (i) to access at least portion of the financial services client data according to the financial service provider participant's scope of authorization, and (ii) to post information to the forum, such that the posted information is accessible to the financial services client and authorized ones of the participants, Examiner disagrees. Applicant is effectively arguing a patentable distinction based on the content of the involved data. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). See also *Ex parte Mathias*, 84 USPQ2d 1276

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(BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; affirmed without written opinion Aug. 17, 2006). Claim 1 only requires that client data be accessible within the scope of access authorized to each participant and falls short of tying function of the content to the scope of the access authorized to each participant.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leonard et al. disclose the role of budget and financial reform in making government work better and cost less. Wood discloses public pension plans in the third millennium. McMahan discloses a program financial advisor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/  
Primary Examiner, Art Unit 3691